

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

KEURIG, INCORPORATED,

Plaintiff,

v.

KRAFT FOODS GLOBAL, INC.,
TASSIMO CORPORATION, and
KRAFT FOODS INC.,

Defendants.

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C.A. No. 07-17 (GMS)

JURY TRIAL DEMANDED

PUBLIC VERSION

DEFENDANTS' OPPOSITION TO PLAINTIFF'S MOTION IN LIMINE NO. 5

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Dated: August 21, 2008
Public Version Dated: August 28, 2008
880384 / 31118

In its *Motion in Limine* No. 5, Keurig misleadingly tells only a small part of the story, leaving out the parts that should be fatal to its motion. After the close of fact discovery, Keurig, through its two technical experts, raised new theories as to why Kraft's asserted prior art does not anticipate claim 1 of the '762 Patent. When Keurig's technical experts were deposed regarding their respective rebuttal reports, they each made statements fatal to the validity of the '762 Patent. Accordingly, Kraft now asserts the defenses of lack of enablement and lack of written description, ***based upon admissions made by Keurig's own technical experts at their deposition.*** In addition, Kraft is asserting the defense of obviousness in response to assertions made by one of Keurig's technical experts for the first time in his rebuttal report.¹

BACKGROUND

As Keurig concedes, Kraft pled in its Answers that the asserted claims of the '762 Patent are invalid under 35 U.S.C. §§ 101, 102, 103, and/or 112. Pursuant to the Court's Scheduling Order, Kraft disclosed three pieces of prior art as anticipating claim 1. In turn, Keurig replied why the disclosed prior art is not anticipatory. Based upon the parties' contentions, Keurig asked the Court to construe the claim term "pierced to accommodate an inflow of liquid". Keurig argued that the term means, "designed to be pierced to form an inlet that allows an inflow of liquid without leakage." D.I. 43 (Ex. 1) at 10. The Court rejected this argument in its claim construction order. D.I. 53 (Ex. 2) at 2, n. 7. Thus, seemingly, the issue of whether the prior art disclosed a lid that when pierced formed a seal that allowed an inflow of liquid without leakage was no longer in the case.

Nevertheless, Keurig's technical expert, Dr. Slocum stated with regard to the prior art Kenco Singles Cartridge ("Singles Cartridge"), "The foil over the coffee bed lacks any kind of

¹ As stated in footnote 1 of its *Motion in Limine* No. 5, Kraft informed Keurig it would drop its laches defense. Nevertheless, Keurig continues to argue about that withdrawn defense.

support structure against which to press a gasket or other device to form a seal.” Slocum Rebuttal Rep. (Ex. 3) at 21. Perhaps Dr. Slocum did not realize at the time of writing his rebuttal expert report that this argument invalidates the ‘762 patent. Neither of the two disclosed embodiments in the ‘762 Patent include a support structure against which to press a gasket or other device to form a seal. Thus, at his deposition, Dr. Slocum was forced to contrive his new “aspect ratio” theory.² Dr. Slocum had to concede, “Based on my model, I don’t think [the cartridge shown in figures] three, four, or five makes a beverage.” Slocum Depo. Tr. (Ex. 4) at 32:2-3. Thus, if Dr. Slocum is correct, then the ‘762 Patent is inoperable.

To avoid an invalidity determination, Keurig is trying to argue through its expert that the prior art Singles Cartridge does not produce a beverage. Keurig did not make this assertion in its reply to Kraft’s invalidity contentions. Nor did it ask the Court to construe the term “beverage.” But now they seek to present the expert testimony of Ted Lingle to construe the term “beverage”, and provide the criteria for determining whether a drink is a beverage under that construction.³ The ‘762 Patent does not disclose any criteria for determining if a drink is a beverage. At his deposition, Mr. Lingle testified that a person of ordinary skill in the art would not know if a particular cartridge produces a “beverage” without consulting a beverage expert. Lingle Depo Tr. (Ex. 5) at 76:2-7. If Mr. Lingle is correct, then the ‘762 Patent is invalid because it does not enable a person of ordinary skill in the art to construct a cartridge that produces a beverage.

Finally, at the beginning of this litigation Kraft asserted that U.S. Patent No. 4,853,234 (“the ‘234 Patent”) discloses each and every limitation of claim 1 of the ‘762 Patent. In its

² At his deposition Dr. Slocum realized that he had unwittingly invalidated the ‘762 Patent, and, thus on the spot he shifted gears arguing that the second disclosed embodiment was operable due to its aspect ratio, which he had not discussed in his rebuttal report. Ex. 4 at 25:3-28:17.

³ Kraft filed a motion *in limine* to exclude Mr. Lingle’s testimony because he tries to provide a specialized definition of “beverage” and is not an expert in the relevant art of the ‘762 Patent.

response to Kraft's invalidity contentions, Keurig asserted that the '234 Patent does not anticipate claim 1 because it does not disclose "a single lid that is both: (1) piercable to accommodate an inflow of liquid into said first chamber for infusion with the beverage medium to produce a beverage; and (2) piercable to accommodate an outflow of the beverage from said second chamber to the exterior of said cartridge." But Keurig did not allege that Kraft's asserted prior art does not disclose the "lid having a first section overlying said first chamber and a second section overlying said second chamber," and Keurig has not amended its responses to Kraft's invalidity contentions to so state. After the close of fact discovery, Dr. Slocum opined that the '234 Patent does not disclose a lid overlying the first and second chambers. Ex. 3 at 3. Kraft is asserting the defense of obviousness, which is clearly pled in its Answers, in response to Keurig's newly raised theory of its own expert. In doing so, Kraft will rely on prior art and evidence produced during discovery.

ARGUMENT

I. Keurig Cannot be Prejudiced By Issues Raised By Its Own Experts

Keurig has proffered expert opinions that raise new issues pertaining to the validity of the '762 Patent. Now, Keurig attempts to claim it is somehow "prejudiced" by its own experts' opinions and disingenuously suggests that Kraft has not articulated the substance of its contentions. Kraft clearly set forth the basis of its Section 112 defenses in its motions *in limine* by noting that Keurig's expert testimony, if true, invalidates the '762 Patent. D.I. 106 at 3 (Ex. 6), D.I. 107 (Ex. 7) at 4. Moreover, Keurig even addresses Kraft's enablement defense in its opposition to the Slocum motion. D.I. 118 (Ex. 8) at 4, n.2. When asked the basis for its obviousness defense prior to Keurig's motion, Kraft pointed to Dr. Slocum's statements in his rebuttal report. (Ex. 9).

As clearly recognized within the Third Circuit, a defendant may raise an affirmative defense so long it is raised at a sufficiently pragmatic time, and the plaintiff is not prejudiced in its ability to respond. *Charpentier v. Godsil*, 937 F.2d 859, 864 (3d Cir. 1991). Here, Keurig not only has notice at a sufficiently pragmatic time, it has timely notice considering that Keurig's Section 112 defense is based on recent admissions by Keurig's technical experts and the Section 103 defense is in response to a new theory raised for the first time by one of Keurig's technical experts in his rebuttal report.

Furthermore, during Kraft's technical expert's deposition, Keurig's counsel elicited testimony from Mr. Taylor indicating that one of skill in the art would recognize that a single lid is needed to achieve a reliable seal with the cartridge disclosed by the '234 Patent. Taylor Depo. Tr. at (Ex. 10) 135:2-136:5. Mr. Taylor repeatedly notes that a design engineer would see that the cartridge was "designed for" a single lid. Ex. 10 at 141:8-18, 143:19-144:11, 180:10-11. Accordingly, Keurig is clearly on notice of Mr. Taylor's expert opinion that a consumer packaging engineer would choose a single lid to close the access opening of a cartridge.

While Keurig would not be prejudiced by allowing Kraft to assert defenses that arise out of assertions and admissions recently made by Keurig's technical experts, Kraft would be prejudiced if it is not allowed to assert those defenses. Keurig should not be allowed to rely on statements by its technical experts that are designed to help it avoid anticipation, and yet not suffer the consequences of the statements by those same experts that invalidate the patent under Section 112 as a matter of law.

II. Kraft Relies Solely on Evidence Already Produced In Discovery

Keurig seeks the extraordinary remedy of barring Kraft from asserting defenses based solely on evidence produced during discovery and upon which its technical experts have opined.

The cases that Keurig cites in support of its motion, which address the late disclosure of new evidence or prior art, are inapposite. In *Primos, Inc. v. Hunter's Specialties, Inc.*, the Federal Circuit held that the trial court did not abuse its discretion by excluding a prior art device that was not disclosed until just before trial. 451 F.3d 841, 851 (Fed. Cir. 2006). Hunter's Specialties failed to disclose the device even though they were aware of its existence over many years of discovery. Each of the *Bridgestone*, *Edizone*, and *Astrazeneca* decisions also were based on the late disclosure of prior art references. Here, Kraft is not asserting new prior art, but is simply relying upon the evidence already known to Keurig and discussed by its technical experts. Kraft is simply relying on the statements of Keurig's technical experts, which if true, render that patent *per se* invalid under Section 112.

In the opinion most directly on point from the District of Delaware, *Cordis Corp. v. Boston Scientific Corp.*, C.A. No. 03-27-SLR, 2005 WL 1331172, at *5 n. 10 (D. Del. June 3, 2005) (citing *Charpentier*, 937 F.2d at 864), the Court found that Boston Scientific (BSC) had not been prejudiced by Cordis' failure to raise a defense in its answer because Cordis provided notice of the defense at pretrial, which gave BSC an opportunity to respond at trial *Id.*; *see also* *Boehringer Ingelheim Int'l GmbH v. Barr Labs.*, C.A. No. 05-700-JJF, 2008 WL 2756127, at *2 (D. Del. July 15, 2008) (defendant permitted to assert invalidity defense raised in pre-trial order)⁴. Here, Keurig will have an adequate opportunity to respond to Kraft's defenses at trial based on the evidence and prior art already produced in this case.

CONCLUSION

For the foregoing reasons, Keurig's Motion *in Limine* No. 5 should be denied.

⁴ The purpose of the joint pre-trial order is to give each party sufficient notice of the opposing party's contentions and an opportunity to respond to such contentions at trial. *Thorn EMI N. Am., Inc. v. Intel Corp.*, 936 F. Supp. 1186, 1191 (D. Del. 1996)(citations omitted).

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**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

CERTIFICATE OF SERVICE

I, David E. Moore, hereby certify that on August 28, 2008, the attached document was electronically filed with the Clerk of the Court using CM/ECF which will send notification to the registered attorney(s) of record that the document has been filed and is available for viewing and downloading.

I further certify that on August 28, 2008, the attached document was Electronically Mailed to the following person(s):

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Exhibit 1

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

KEURIG, INCORPORATED,

Plaintiff,

v.

KRAFT FOODS GLOBAL, INC.,
TASSIMO CORPORATION, and
KRAFT FOODS INC.,

Defendants.

Civil Action No. 07-017-GMS

KEURIG INCORPORATED'S OPENING CLAIM CONSTRUCTION BRIEF

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Attorneys for Plaintiff Keurig, Incorporated

Dated: October 15, 2007

A. **“piercable to accommodate an inflow of liquid” and
“piercable to accommodate an outflow of beverage”**

Language from Claims 1 and 10 that Keurig Suggests Requires Construction	Keurig's Proposed Construction
piercable to accommodate an inflow of liquid	designed to be pierced to form an inlet that allows an inflow of liquid without leakage
piercable to accommodate an outflow of beverage	designed to be pierced to form an outlet that allows an outflow of beverage without leakage

The claim language “piercable to accommodate an inflow of liquid” and “piercable to accommodate an outflow of beverage” should be construed as complete phrases and in the context of the entire claim, as clarified by the specification. The adjective “piercable” cannot be taken in isolation and construed in a vacuum as Kraft urges the Court to do. This word is part of larger phrases whose meaning lies at the heart of the claimed invention of the ‘762 patent, which is directed to **same-side piercing** of a single-serve beverage filter cartridge lid to create “a cleaner puncture and an improved seal” that avoids leakage.

While just about anything is theoretically “piercable” if given the right tools and enough force, the patent plainly does not cover any and all lids that can somehow be pierced. Rather, it covers a cartridge with a lid that is piercable in a particular manner, namely “to accommodate an inflow” or “outflow.” What does this qualification to the word “piercable” require? As discussed below, the patent specification answers this question by clarifying that it must be designed to be pierced **so as to form** a particular type of seal onto an **inlet and outlet**, avoiding leakage.

The adjective “piercable” in claims 1 and 10 must be construed along with the claim language that it modifies, “to accommodate an inflow of liquid” and “to accommodate an outflow of beverage,” in the context of the entire claim. “Proper claim construction . . . demands interpretation of the entire claim in context, not a single element in isolation.” Pause Tech. LLC

Exhibit 2

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

KEURIG, INCORPORATED,)	
)	
Plaintiff,)	
)	
v.)	Civil Action No. 07-017 (GMS)
)	
KRAFT FOODS GLOBAL, INC.,)	
TASSIMO CORPORATION, and)	
KRAFT FOODS INC.,)	
)	
Defendants.)	
)	
)	

ORDER CONSTRUING THE TERMS OF U.S. PATENT NO. 6,607,762

On December 3, 2007, the court held a *Markman* hearing in this patent infringement action concerning U.S. Patent No. 6,607,762 (the “‘762 patent” or the “patent-in-suit”). After having considered the submissions of the parties and hearing oral argument on the matter, IT IS HEREBY ORDERED, ADJUDGED, and DECREED that, as used in the asserted claims of the ‘762 patent:

1. The term “first and second chambers” is construed to mean, with regard to the first chamber, “the part of the cartridge into which the liquid is introduced and through which it flows before reaching the filter,” and, with regard to the second chamber, “the part of the cartridge out of which the beverage flows after having passed through the filter.”¹

¹ In the court’s view, Keurig’s proposed construction better comports with the claim language and the specification, which disclose a filter defining two chambers both covered by a lid through which liquid enters one chamber and exits the other. ‘762 patent at 04:60-05:12; *see also id.* at 03:15-20 (embodiment in which filter defines one chamber, which receives the liquid, separate from the second chamber, from which the beverage exits). Accordingly, the court adopts this construction. *Merck & Co. v. Teva Pharms. USA, Inc.*, 347 F.3d 1367, 1371 (Fed. Cir. 2003) (construing terms to have the meaning presented in the patent document).

2. The term “a [planar]² filter element received in and configured and arranged to subdivide the interior of said container into first and second chambers” is construed to have its plain and ordinary meaning.³
3. The term “and a second section overlying said second chamber” is construed to have its plain and ordinary meaning.⁴
4. The term “piercable”⁵ is construed below as part of the terms “piercable to accommodate an inflow of liquid into said first chamber” and “piercable to accommodate an outflow of the beverage from said second chamber to the exterior of said cartridge.”⁶
5. The term “piercable to accommodate an inflow of liquid” is construed to mean “capable of being pierced to permit a flow of liquid into.”⁷

² Claim 10 repeats this disputed term, which first appears in Claim 1, verbatim but for the addition of the word “planar” where indicated. *Cf.* ‘762 patent at 04:63 with *id.* at 06:10. The parties agree that, for the purposes of this case, this difference is immaterial. (D.I. 42 at 4.).

³ This construction derives from the court’s construction of “first and second chambers” and the term’s otherwise ordinary meaning. *See* footnote 1; *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) (*en banc*), *cert. denied*, 546 U.S. 1170.

⁴ The court declines to adopt Kraft’s construction, which would impermissibly read limitations from the preferred embodiment onto the claims. *Comark Commc’ns, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186 (Fed. Cir. 1998).

⁵ This is the spelling used in the ‘762 patent.

⁶ *See* footnote 7.

⁷ Keurig argues that Kraft’s proposed construction is so overbroad as to render these terms meaningless. *Cf. Nikken USA, Inc. v. Robinsons-May, Inc.*, 51 Fed. Appx. 874, 884–85 (Fed. Cir. 2002) (citing *Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 93 F.3d 1572, 1578 (Fed. Cir. 1996)) (rejecting construction of claim term “attachable” because construction’s overbreadth rendered the limitation meaningless). The court should instead adopt Keurig’s proposed construction, Keurig argues, because that construction conveys the ‘762 patent’s special, innovative purpose: avoiding leakage by locating the outlet at lid, not the cartridge base as in prior art. *See Medrad*, 401 F.3d at 1319 (claim construction must take place in context of specification and prosecution history, including invention’s function, not in a vacuum). The specification does describe the invention’s purpose. *E.g.*, ‘762 patent at 01:38–63. But certain prior art, cited in both the ‘762 patent’s specification and prosecution history and so part of the intrinsic record, undermines the basis of Keurig’s proposed construction. *Phillips*, 415 F.3d at 1317 (prosecution history, including prior art cited therein, is part of intrinsic record); *see* ‘762 patent at 01:17 (specifically citing as prior art U.S. Patent Nos. 5,325,765 and 5,840,189); (D.I. 47 at A19–22 (patentee citing prior art during examination).) Specifically, the prior-art ‘189 patent uses virtually this same disputed term to describe piercing both the lid and the base to accommodate liquid flow – even though that prior art lacks the patent-in-suit’s focus on leakage and its

Exhibit 3

**THIS EXHIBIT HAS BEEN
REDACTED IN ITS ENTIRETY**

Exhibit 4

1 UNITED STATES DISTRICT COURT
2 FOR THE DISTRICT OF DELAWARE

3 ----- x
4 KEURIG, INCORPORATED,

5 Plaintiff,

6 v.

7 KRAFT FOODS GLOBAL, INC., TASSIMO CORPORATION, and
8 KRAFT FOODS INC.,

9 Defendants.
10

11 Civil Action No. 07-CV-0017-GMS
12 ----- x

13 VIDEOTAPED DEPOSITION OF ALEXANDER H. SLOCUM

14 Wednesday, June 11, 2008

15 9:10 a.m. to 5:00 p.m.

16 WOLF, GREENFIELD & SACKS, P.C.

17 600 Atlantic Avenue

18 Boston, Massachusetts

19 Reporter: Marianne R. Wharram, CSR/RPR
20

21
22
23 ELLEN GRAUER COURT REPORTING CO. LLC

24 126 East 56th Street, Fifth Floor

25 New York, New York 10022

212-750-6434

REF: 87765

1 SLOCUM

2 that.

3 Q. We're going to get to that in length. What
4 else do you disagree with with Mr. Taylor?

5 MR. RADER: Same objection. You can
6 answer.

7 A. I want to make sure I accurately describe
8 it.

9 Q. (BY MR. SCHLITZ) Yeah, please do.

10 A. Well, I think that's the -- that's the
11 primary thing, and that this device, he says on 20
12 -- excuse me, paragraph 20 --

13 Q. Yes.

14 A. -- he says a person skilled in the art
15 reviewing '234 would understand specifications to
16 describe a cartridge that could be used for
17 same-side piercing, even though it was designed for
18 opposite side. And I just disagree, and my --
19 okay. I'll --

20 Q. On what basis do you disagree?

21 A. Okay. I was going to wait for you to ask
22 the next question.

23 Q. Yeah. Go ahead.

24 A. Well, when I run tests -- well, so there's
25 two things. First of all, there's some scientific

1 SLOCUM

2 philosophies or whatever why this type of approach
3 for this type of aspect ratio cartridge I -- is my
4 opinion fundamentally doesn't work well, if at all.
5 If you delete the manifolds and you just do
6 same-side piercing and with respect to can you
7 actually same-side pierce something like this
8 without making a mess, that's a separate --
9 separate issue, but just in terms of making a
10 beverage, and I believe, as I described when I
11 wrote my report, that when I run tests, I don't get
12 a beverage in the definition of my palate or
13 Mr. Lingle's expert opinion.

14 Q. Let me understand what you just said.
15 First of all, when you said a cartridge, a rati--
16 what did you --

17 A. Aspect ratio.

18 Q. What is an aspect ratio of a cartridge?

19 A. Okay, so when you -- when you want to
20 describe the aspect ratio of something -- so if I
21 can have a pen?

22 Q. Here's a pen.

23 A. It's easier for me to point with this than
24 a finger. This is a little flatter than your
25 typical cartridge, but specifically, when I'm

1 SLOCUM

2 referring to aspect ratio, the length and the width
3 of a coffee bed and what's those -- what are those
4 proportions with respect to the depth between where
5 you're putting in the fluid and where it wants to
6 exit.

7 Q. All right.

8 A. Now, all these flat cartridges, I would
9 say, have a flat aspect ratio. The depth is
10 shallow.

11 Q. When you say these, you were pointing to
12 something.

13 A. I'm sorry. The Singles cartridges or the
14 cartridge from the '234 patent.

15 Q. Okay.

16 A. So when you go -- or the embodiment of
17 Figure -- nominally, Figure 4.

18 Q. Right.

19 A. Now, compare those proportions to what I
20 think is the actual useful embodiment of Figures 6,
21 7 and 8 of the '762 patent, which is that aspect
22 ratio is more kind of one-to-one, the depth with
23 here, and in the actual, these flat type
24 cartridges, it's like three or four-to-one is the
25 characteristic aspect ratio. The problem with just

1 SLOCUM

2 taking something of this aspect ratio and piercing,
3 in the language of the patent, and then injecting
4 your fluid is that the water, which comes in at a
5 reasonable pressure, shoots right through the
6 coffee, or whatever your drink is, into the filter
7 and then rushes out your filter, so you don't get
8 good wetting -- that's wetting, excuse me -- of the
9 bed of -- and you end up putting through the
10 required amount of fluid to fill your cup, but it
11 really only acts on a small region of coffee, which
12 is why I think it comes out so -- so weak and why I
13 said yeck, it doesn't really taste like coffee.
14 When you have a -- and that's why I believe the
15 '234 and the Singles, they both have this
16 manifolding system --

17 Q. All right.

18 A. -- to evenly wet. And I opened up
19 cartridges from the Singles machine after they were
20 used and I looked at the bed and I opened up the
21 cartridges after I would do my test and I looked at
22 the bed, and the tests I ran, you would always
23 burrow a hole. And I can discuss more in terms of
24 scientific principles of aspect ratios if you want.

25 Q. Please do.

1 SLOCUM

2 A. Based on my model, I don't think three,
3 four, five makes a beverage.

4 Q. Now, when you were talking about the aspect
5 ratio, and with regard to Figure 13, okay --

6 A. Correct.

7 Q. -- you say because -- in Figure 13, are you
8 aware that the -- well, in what orientation would
9 you have to use Figure 13?

10 A. Um, I actually think it would -- it would
11 work -- this vertical orientation -- it would work
12 vertical orientation where, for example -- and it
13 would work in several.

14 Q. Okay.

15 A. It would work vertical orientation where
16 the gravity vector points -- I'm trying to figure
17 out how I'm going to do this with the video thing,
18 but where the area of the gravity vector would be
19 located on the lid.

20 Q. Would the foil be down or up or sideways?

21 A. That's a better way of putting it. The
22 foil would be -- down would work. I believe it
23 would work with the foil vertical.

24 Q. Right.

25 A. With the foil horizontal, or up, excuse me,

Exhibit 5

1 UNITED STATES DISTRICT COURT
2 FOR THE DISTRICT OF DELAWARE

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3 KEURIG, INCORPORATED,
4 Plaintiff,
5 VS
6 KRAFT FOODS GLOBAL, INC., TASSIMO
CORPORATION, and KRAFT FOODS, INC.,
7
8 Defendants.

Civil Action No. 07-CV-0017-GMS

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10
11
12 VIDEOTAPED DEPOSITION OF TED R. LINGLE

13 Friday, June 27, 2008

14 9:11 a.m. - 2:05 p.m.

15 WOLF, GREENFIELD & SACKS, P.C.

16 600 Atlantic Avenue

17 Boston, Massachusetts 02210

18
19 Court Reporter: Loretta Hennessey, RDR, CRR
20
21
22

23 ELLEN GRAUER COURT REPORTING CO. LLC

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24 New York, New York 10022

212-750-6434

25 REF: 87840

1 LINGLE

2 Q. Okay. So one who is of ordinary skill in
3 the art in designing and making single-serve
4 beverage cartridges wouldn't have a metric, that
5 person would have to go to an expert in coffee; is
6 that correct?

7 A. That's correct.

8 Q. Okay. What is the measure of acceptable
9 aroma profile?

10 A. That's also subjective.

11 Q. Okay. And one of ordinary skill in the
12 art, an engineer in building, constructing
13 single-serve beverage cartridges, what would be the
14 metric that person would have to use to determine if
15 the resultant beverage satisfies the aroma profile?

16 A. That would also be subjective. They would
17 taste and smell the fluid and say, "yes, this smells
18 like coffee," or, "no, this doesn't smell like
19 coffee."

20 Q. Okay. But what I'm trying to understand
21 is what if that engineer, you know, thinks that a
22 beverage that has just barely traceable aroma is
23 acceptable. Would you accept that?

24 A. Accept it in what way?

25 Q. Well, since it's subjective, could that

Exhibit 6

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Defendants.

)
)
)
)
) C.A. No. 07-17 (GMS)

) **JURY TRIAL DEMANDED**

) **CONFIDENTIAL –**
) **ATTORNEY EYES ONLY**
) **FILED UNDER SEAL**
)

**DEFENDANTS' MOTION IN LIMINE TO LIMIT EXPERT
TESTIMONY OF DR. ALEXANDER SLOCUM**

OF COUNSEL

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Dated: August 4, 2008
877077 / 31118

*Attorneys for Defendants
Kraft Foods Global, Inc., Tassimo
Corporation, and Kraft Foods Inc.*

'762 Patent, Col. 2, Lines 14-20. The figures for the two disclosed embodiments do not disclose a support structure against which to press a gasket or other device to form a seal.

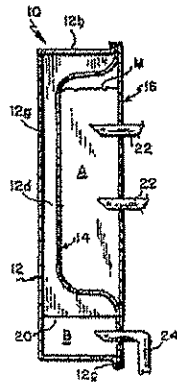


FIG. 5

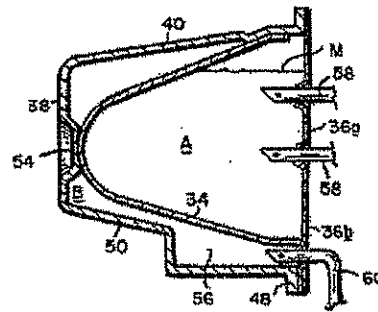


FIG. 13

Thus, Dr. Slocum's opinion as to why Kraft's asserted prior art is not suitable for same-side piercing, if correct, would also apply to the '762 Patent, thereby rendering the asserted claims invalid for lack of enablement. Realizing the dilemma his opinion placed Keurig in, at his deposition, Dr. Slocum on the spot abandoned his argument regarding the need for a support structure and invented a new theory why Kraft's prior art would not invalidate the '762 Patent's claims. He raised his new "aspect ratio" theory.

He proceeded to opine that the '234 Patent and Singles cartridge, as well as the first embodiment of the '762 Patent, are not suitable for same side piercing because the cartridges have a flat aspect ratio. Slocum Dep. Tr. (Ex. 3) 27-28, 31-32. Dr. Slocum then asserted that a cartridge must have a one-to-one aspect ratio, like the embodiment shown in Figs. 7-9 of the '762 Patent, to directly inject fluid into the coffee bed for same side piercing. *Id.* at 27. But nowhere in his Expert or Rebuttal report does Dr. Slocum assert that Kraft's prior art fails to anticipate the '762 Patent due to its aspect ratio, nor does he discuss that for the same reason the first embodiment of the '762 Patent is inoperative. Plain and simple, Kraft was ambushed by Dr. Slocum at his deposition.

Exhibit 7

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT DELAWARE

KEURIG, INCORPORATED,

Plaintiff,

v.

KRAFT FOODS GLOBAL, INC.,
TASSIMO CORPORATION, and
KRAFT FOODS INC.,

Defendants.

)
)
)
)
) C.A. No. 07-17 (GMS)

) JURY TRIAL DEMANDED

) CONFIDENTIAL –
) ATTORNEY EYES ONLY
) FILED UNDER SEAL
)

DEFENDANTS' MOTION IN LIMINE TO PRECLUDE
EXPERT TESTIMONY OF TED LINGLE

OF COUNSEL

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Dated: August 4, 2008
877075 / 31118

*Attorneys for Defendants
Kraft Foods Global, Inc., Tassimo
Corporation, and Kraft Foods Inc.*

purported coffee brewing expert testify that in his judgment a drink does not meet his subjective criteria as to acceptable taste, odor, color, or strength to qualify as a cup of coffee. Mr. Lingle contends that a person of ordinary skill in the art could not even ascertain what a “beverage” is without consulting an expert. Lingle Dep. Tr. (Ex. 2) at 75-76. Of course, this renders the claims indefinite.³ See 35 U.S.C § 112.

II. Lingle’s Testimony Would Not Assist the Trier of Fact

Under Rule 702, expert testimony must “assist the trier of fact to understand the evidence or to determine a fact in issue.” *Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579, (1993) (quoting Fed. R. Evid. 702). Mr. Lingle’s testimony is not intended to assist the jury in understanding the evidence and making a factual determination. Rather, it is intended to set criteria for a beverage that are not in the patent-in-suit and then tell the jury that in his judgment the drink produced by the Singles cartridge does not have the flavor, color, odor or strength to qualify as a cup of coffee.

III. Lingle is Not an Expert in the Relevant Art of the ‘762 Patent

Rule 702 also requires that a technical expert in a suit for patent infringement have specialized knowledge in the relevant art of the patent-in-suit. See *Elcock v. Kmart Corp.*, 233 F.3d 734, 741 (3d Cir. 2000); *In re Paoli R.R. Yard PCB Litigation*, 35 F.3d 717, 743 (3d Cir. 1994) (must be connection between expert testimony and factual issues in the case). But Mr. Lingle lacks expertise in brewer or beverage cartridge design, or even fluid mechanics. Lingle Dep. Tr. (Ex. 2) at 18, 93-94. In short, Mr. Lingle is not an expert in the single-serve beverage filter cartridge art – the relevant art of the ‘762 Patent. Rather, he is an expert in “[c]offee,

³ Mr. Lingle’s proposed definition of “beverage” runs contrary to the maxim that claims should be construed to preserve validity. See *Lucent Technologies, Inc. v. Gateway, Inc.*, 525 F.3d 1200, 1215 (Fed. Cir. 2008).

Exhibit 8

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

KEURIG, INCORPORATED,

Plaintiff,

v.

KRAFT FOODS GLOBAL, INC.,
TASSIMO CORPORATION, and
KRAFT FOODS INC.,

Defendants.

Civil Action No. 07-017-GMS

**KEURIG'S OPPOSITION TO DEFENDANTS' MOTION *IN LIMINE*
TO PRECLUDE EXPERT TESTIMONY OF DR. ALEXANDER SLOCUM**

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Attorneys for Plaintiff Keurig, Incorporated

Dated: August 15, 2008

See Taylor Depo. (Ex. C) at 107. By contrast, as noted above, Professor Slocum carefully evaluated the liquids and reported on his observations in his expert report. While Professor Slocum is not a coffee expert like Mr. Lingle, and will not duplicate Mr. Lingle's expert testimony, he is entitled to describe his own observations as a skilled engineer performing his experiments and observing the resulting liquids. Professor Slocum's observations of the Singles liquids are not subject to attack by Kraft and are admissible at trial.

C. Professor Slocum is Entitled to Testify Regarding the Singles Cartridge's Aspect Ratio, Which Merely Explains His Description of the "Burrowing" Phenomenon in His Rebuttal Expert Report.

Professor Slocum's testimony regarding the "aspect ratio" of the Singles cartridge clearly complies with Rule 26(a)(2)(B) because it is merely an explanation of the burrowing phenomenon that he disclosed in his rebuttal expert report.² As noted above, Professor Slocum's report explains that in a shallow Singles cartridge, the pressurized water "shoots through the coffee grounds and literally burrows a hole." (Ex. A at 25). When pressed for further details about this phenomenon at his deposition, Professor Slocum explained the connection between the "shallowness" (or flat "aspect ratio") of the cartridge and the burrowing problem:

The problem with just taking something of this aspect ratio and piercing ... and then injecting your fluid is that the water, which comes in at a reasonable pressure, shoots right through the coffee, or whatever your drink is, into the filter and then rushes out your filter, so you don't get good wetting....And I opened up cartridges...after they were used and....you would always burrow a hole. And I can discuss more in terms of scientific principles of aspect ratios if you want.

(Ex. B at 27-28) (emphasis added).

² Professor Slocum's rebuttal report describes both the "sealing" and "burrowing" problems that occur when Singles cartridges are used in a same-side piercing configuration. (Ex. A at 21, 25). Kraft's suggestion in its motion (at 3) that Professor Slocum invented the latter at his deposition is wrong. Likewise, Kraft's suggestion (at 3) that Professor Slocum's testimony raised enablement issues is baseless – indeed, prior to filing its motion *in limine* (more than two months after Professor Slocum's deposition), Kraft never even mentioned enablement. It would be far too late for Kraft to raise such a defense this close to trial.

Exhibit 9

Foster, William

From: Foster, William
Sent: Wednesday, August 13, 2008 7:44 PM
To: 'Michael Rader'
Cc: 'Charles Steenburg'; Schlitz, David
Subject: RE: Keurig v. Kraft

Mike,

I am forwarding revised Jury Instructions, Contentions, and Verdict Form. We intend to assert the defenses of obviousness of claim 1, enablement and written description. Kraft's initial pleadings assert defenses of invalidity under Sections 103 and 112 and we have never indicated that they were withdrawn. During expert discovery, Keurig raised new theories responding to Kraft's invalidity contentions that necessitate the inclusion of instructions with regard to these defenses.

In its responses to Kraft's invalidity contentions, Keurig did not assert that the '234 Patent failed to disclose a lid that overlies the first and second chambers. Instead, Keurig argued that the '234 Patent fails to disclose a lid that is both piercable to accommodate an inflow and piercable to accommodate an outflow. But Dr. Slocum's report (at Paragraph 10) clearly indicates that he will testify the '234 Patent does not disclose a single lid overlying the first and second chambers. In this regard, Keurig has not amended its response to Kraft's invalidity contentions.

Further, either of Dr. Slocum's alternative opinions regarding piercability, one from his rebuttal report and a different one at deposition, would render the '762 Patent invalid under section 112. We detailed how Dr. Slocum's opinions, if accepted, invalidate the '762 Patent in our motion *in limine* related to his testimony.

I will be available to discuss these issues anytime tomorrow.

Thanks,
Bill

-----Original Message-----

From: Michael Rader [mailto:Michael.Rader@WolfGreenfield.com]
Sent: Wednesday, August 13, 2008 1:33 AM
To: Foster, William
Cc: Steenburg, Charles; Keller, Karen; Albert, Michael
Subject: Keurig v. Kraft

Dear Bill,

Please let me know when this afternoon would be a convenient time for you to meet and confer by telephone about the new defenses that Kraft apparently intends to raise based on the draft jury instructions that you provided to us this week. While we still have no disclosure from you of the nature of these defenses, we do note that Kraft intends to ask for jury instructions on laches, obviousness of claim 1, enablement and written description. None of these defenses have ever been articulated before and Keurig intends to promptly file a motion to exclude them. Please let us know if Kraft ever provided notice of the nature of these defenses in its invalidity contentions, interrogatory answers or expert reports. We have reviewed those papers and found nothing.

We intend to have our motion on file in the next day or two. We should agree on a briefing schedule that will permit the motion to be fully briefed by August 25 in compliance with Judge Sleet's scheduling order. I propose that Kraft file its opposition by Wednesday, August 20 and Keurig will file its reply by August 25.

I can be available for a meet-and-confer this afternoon after about 2 pm.

8/21/2008

Best regards,

Michael Rader

WOLF, GREENFIELD & SACKS, P.C.

8/21/2008

Exhibit 10

In The Matter Of:

***KEURIG, INCORPORATED v.
KRAFT FOODS GLOBAL, INC***

MALCOLM E. TAYLOR
July 3, 2008

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TAYLOR, MALCOLM E. - Vol. 1

1 A. Yes, okay.

2 Q. That's the basis for your opinion that there is a
3 single piece of foil covering the entire side that's
4 shown in figure 5?

5 A. That's not the only reason. Actually, the cartridge
6 is designed with a flange all the way around the
7 device which has a larger width than anywhere else
8 on the cartridge which is what I would do if I was
9 making this up to apply a label or a lid, if you
10 like, in this case over the full surface. In order
11 to have a reliable seal, you need enough width of
12 flange in order to get that to occur. If you work
13 with a narrow flange, it isn't going to work too
14 well and it isn't going to last too long.

15 Q. You are talking about the narrow -- you are talking
16 about the top of the wall 39 in figure 5?

17 A. Well, I'm talking about the flange which runs all
18 the way around which is --

19 Q. So are you suggesting that it wouldn't work well to
20 seal that foil to the top of the wall 39 in
21 figure 5?

22 A. No, I wouldn't.

23 Q. And that's one of the assumptions underlying your
24 opinion that this patent describes a foil covering

1 the entire side?

2 A. Absolutely. This is designed with a wider flange
3 all the way around the device. This one is only an
4 internal divider. That's all it is as designed
5 there.

6 Q. Now, are you aware that a cartridge of the design in
7 figures 4 and 5 in the '234 Patent was
8 commercialized for a period of time by Kraft?

9 A. It was, but I know the reason too.

10 Q. Now, let me show you a picture of that. This is a
11 picture of Exhibit 81 which is that cartridge. Are
12 you familiar with this photo?

13 A. No, I'm not. No, I haven't seen this before.

14 Q. I'll represent to you it's a photograph of a
15 cartridge that Mr. MacMahon brought to the second
16 day of his deposition. Do you recall reading about
17 that?

18 A. Yes, I do remember it.

19 Q. Okay. And do you recall reading that he testified
20 that this cartridge is the commercial embodiment
21 that's being described in the '234 Patent?

22 MR. SCHLITZ: Objection. Mischaracterizes
23 his testimony.

24 A. No. What I remember him mentioning earlier in his

1 Q. And at the same time, sir, I'd like you to turn to
2 the portion of the '234 Patent that you cite in your
3 report which is column 7, line 17 through 21.

4 A. Column what, sir?

5 Q. Column 7, line 17 through 21. You cite that in your
6 report, right, in the middle of page 14?

7 A. Right.

8 Q. And the sentence there that you are citing is "In
9 use a laminated foil is sealed both along the upper
10 edge 22 of the body portion and the lower edge 23 of
11 the body portion"?

12 A. Yes.

13 Q. And you are citing that in your report for the idea
14 that the foil lid covers the entirety --

15 A. That's correct.

16 Q. -- of the side shown in figure 5?

17 A. Yes, because I think that's what it was designed
18 for.

19 Q. Now, I'd like you to please look at page 15 of
20 Mr. MacMahon's transcript?

21 A. Yes.

22 Q. Line 14, I directed his attention to column 7, this
23 is line 18, "In use a laminated foil is sealed both
24 along the upper edge 22 of the body portion and the

1 you have in the sample in your hand, and not a foil
2 that would cover the entire side including the
3 outlet?" And his answer was yes, correct?

4 A. Yes.

5 Q. So do you understand Mr. MacMahon's testimony?

6 A. I see it, yeah.

7 Q. And you understand that in substance his testimony
8 is that the patent is describing a foil like what's
9 shown in Exhibit 81 as opposed to one that covers
10 the entire side?

11 MR. SCHLITZ: Objection.

12 A. I see that.

13 Q. And you stated earlier in your deposition today that
14 if the question came up about the meaning of some
15 language in one of the Kraft patents that
16 Mr. MacMahon was an inventor, you would defer to him
17 on what that language meant, didn't you?

18 A. Yes, I did.

19 Q. So would you agree with me that you'd have to defer
20 to Mr. MacMahon that the '234 Patent describes an
21 embodiment in which the foil covers the coffee bed
22 but not the outlet?

23 A. In this case no, because it doesn't make any sense.

24 Q. So in this case you won't defer to Mr. MacMahon's

1 testimony?

2 A. No, because I think he's wrong.

3 Q. Even though he's the inventor?

4 A. Yeah, absolutely. I mean I've designed enough of
5 these things in my life where I have to make a heat
6 seal. Nobody in their right mind would design a
7 thing like that with a disk over a little area, and
8 you'd have -- I mean you would have a narrow rib
9 sealing the bottom of the label over the bed of the
10 coffee base because, you know, I don't think it's
11 designed for it.

12 Q. Mr. Taylor, are you aware as you sit here today
13 based on the reading that you did that this
14 cartridge in Exhibit 81 was sold commercially for
15 over a year?

16 A. Yes, I am.

17 Q. You are aware of that?

18 A. I am.

19 Q. Now, I'd like to show you Mr. Bentley's transcript
20 for a moment. While Charlie is getting that, do you
21 know what the Mark II and Mark III capsules refer
22 to?

23 A. No, I don't think so because I don't know that I
24 ever saw them in reality. I think I remember the

1 A. Yes.

2 MR. RADER: Objection. Leading.

3 A. Yes, it is.

4 Q. Does the fact that Mr. Rader questioned you at
5 length about statements that Mr. Bentley and
6 Mr. MacMahon expressed about the commercial product,
7 do those statements in any way change your view that
8 this lid -- ledge 23 goes the whole way around?

9 A. No, it doesn't. That's what I indicated earlier.
10 This is my independent -- as a design engineer it
11 runs all the way around. It's designed for one lid.

12 Q. And your opinion is based on reading the '234
13 Patent; is that correct?

14 A. Yes.

15 Q. And your opinion is not based on reading
16 Mr. MacMahon or Mr. Bentley's deposition; is that
17 correct?

18 A. That's correct.

19 Q. Let's assume for the sake of argument in this case
20 that the commercial embodiment of the Mark II had
21 two lids, would that change your opinion as to what
22 the '234 Patent shows?

23 A. No, it wouldn't.

24 MR. SCHLITZ: Okay. I have no other